

REMARKS

Claims 6-12 and 20-25 are pending in the present application. Claims 13-19 have been canceled.

Claim Rejections-35 U.S.C. 101

Claims 13-25 have been rejected under 35 U.S.C. 101, as allegedly being directed to non-statutory subject matter. The Examiner has alleged that the claims are not tied to a particular machine or apparatus, and also do not transform a particular article into a different state or thing. This rejection is respectfully traversed for the following reasons.

Claims 13-19 have been canceled as noted above merely to advance prosecution. Applicants however do not concede that claims 13-19 are non-statutory. The following comments are directed to claims 20-25.

The Examiner has attempted to apply the machine-or-transformation test as set forth in *In re Bilski*, 545 F.3d 943, 88 U.S.P.Q.2d 1385 (Fed. Cir. 2008). Applicants however respectfully submit that claim 20 is clearly tied to a particular machine or apparatus, and that the Examiner has misapplied the test as set forth in *In re Bilski*.

The Examiner is respectfully directed to the Memo from the Deputy Commissioner for Patent Examination Policy dated May 15, 2008 regarding Clarification of "Processes" under 35 U.S.C. § 101. As set forth therein, the Office's guidance to Examiners is that a § 101 process must (1) be tied to another statutory class (such as a

particular apparatus), or (2) transform underlying subject matter to a different state or thing.

As further set forth in the Memo from the Deputy Commissioner, an example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should as a first alternative positively recite the other statutory class (the thing or product) to which it is tied, ***"for example by identifying the apparatus that accomplishes the method steps"***. If the claimed method is determined to be a statutory subject matter eligible process, the inquiry proceeds to determine whether the claimed invention falls within a judicial exception (law of nature, natural phenomena, or abstract idea).

Applicants respectfully submit that the karaoke service method for a mobile device of claim 20 is clearly tied to another statutory class, that is a particular apparatus (mobile device). Claim 20 clearly recites the apparatus that accomplishes the method steps. For example, claim 20 features storing karaoke contents including karaoke event data in time order and a song data **in a memory of the mobile device**. Moreover, sound is played responsive to the song data and an interrupt signal is generated **using a sound generator of the mobile device**. Also, karaoke events are executed responsive to an interrupt signal **using a multi-media processor of the mobile device**. Thus, it should be readily understood that claim 20 clearly identifies the apparatus that accomplishes the method steps, and is thus tied to another statutory class in compliance with the guidance set forth in the above noted Memo from the

Deputy Commissioner.

On page 3 of the Final office Action dated November 2, 2009, the Examiner has alleged that the above noted features of claim 20 "do not impart meaningful limitation on the scope of the claim as it merely provides intended use of data structure, the limitation does not recite a particular machine which is critically tied to the performance of the method".

Applicants respectfully submit that the Examiner's assertion that claim 20 does not recite a particular machine which is critically tied to the performance of the method is clearly erroneous on its face, as evidenced above. This assertion by the Examiner appears to be directly contrary to the above noted guidelines set forth in the Memo from the Deputy Commissioner, because claim 20 does indeed identify the apparatus that accomplishes the method steps.

Moreover, the Examiner has raised the issue of "intended use of data structure". However, the Examiner has failed to identify the particular case law or guidance relied upon in raising the issue of "intended use" with respect to statutory subject matter as pertaining to method claims. "Intended use" does not appear to be mentioned as a consideration in the Memo from the Deputy Commissioner. The issue of "intended use" in this instance would thus appear irrelevant.

The Examiner has further asserted on page 3 of the Final Office Action dated November 2, 2009, that claim 20 "merely uses computer componentry but does not show that the computer performs any of the functions". As emphasized above, claim

20 recites a memory, a sound generator and a multimedia processor, not merely "computer componentry" as asserted by the Examiner. This assertion by the Examiner would thus appear to be clearly erroneous.

Applicants respectfully submit that the karaoke service method for a mobile device of claim 20 is clearly tied to a mobile device. The claimed method should thus be recognized as a statutory subject matter eligible process within the guidelines as provided by *In re Bilski*. Moreover, the claimed invention clearly does not fall within a judicial exception such as a law of nature, a natural phenomena, or an abstract idea. Accordingly, Applicants respectfully submit that claims 20-25 are clearly directed to statutory subject matter and thus are in compliance with 35 U.S.C. 101, and that this rejection is improper for at least these reasons.

Claim Rejections-35 U.S.C. 102

Claims 6-25 have been rejected under 35 U.S.C. 102(e) as being anticipated by the Naples et al. reference (U.S. 2002/0162445). This rejection is respectfully traversed for the following reasons.

As emphasized previously, Applicants respectfully submit that the Naples et al. reference as particularly relied upon by the Examiner does not specifically disclose song data having synchronization data embedded therein.

On page 4 of the Final Office Action dated November 2, 2009, the Examiner has directed attention to paragraphs 5, 48 and 49 of the Naples et al. reference as

disclosing song data having synchronization data embedded therein. On page 12 of the Final Office Action, the Examiner has reproduced paragraph 5 of the Naples et al. reference in its entirety in an attempt to establish that the Naples et al. reference discloses song data having synchronization data embedded therein. Applicants respectfully submit that the Examiner has misconstrued the above noted various portions of the Naples et al. reference as disclosing features that simply are not described therein.

In particular, paragraph [0005] of the Naples et al. reference generally describes MIDI streams and files. The Examiner has asserted on page 12 of the Final Office Action that "the sheet music not only provides the notes each of the instrument is playing, but also the synchronized timing of when each of the notes is played (how the content is to be synthesized)" (our emphasis added). However, paragraph [0005] of the Naples et al. reference does not even mention the words "synchronized timing. More particularly, paragraph [0005] of the Naples et al. reference does not describe or even remotely suggest song data having synchronization data embedded therein.

Paragraph [0048] of the Naples et al. reference merely discloses that the standardized performance is encoded in one or more parts that can be played back synchronously by an interactive karaoke system. Paragraph [0048] of the Naples et al. reference does not specify synchronization data, synchronization data embedded in song data, or how synchronous playback of one or more parts is achieved.

Paragraph [0049] of the Naples et al. reference merely discloses in a very

general manner that a data file contains additional content such as timing cues, lyrics and other features "that will be explained". The additional content is timed as correlated to the audio content for synchronous playback. However, paragraph [0049] of the Naples et al. reference does not specifically describe synchronization data, synchronization data embedded in song data, or the manner in which the additional content is timed-correlated to audio content for synchronous playback.

On page 13, lines 13-15 of the Final Office Action dated November 2, 2009, the Examiner has asserted with respect to synchronization data and synchronization data embedded within song data, that paragraphs [0010], [0048] and Figs. 15A of the Naples et al. reference have previously been cited as providing the necessary teachings, and that Applicants have not addressed the features taught in these cited portions of the Naples et al. reference.

However, contrary to the Examiner's assertion, paragraph [0010] and Fig. 15A of the Naples et al. reference were addressed in detail on page 16, line 7 through to page 17, line 20 of the previous Amendment dated June 19, 2009. Further contrary to the Examiner's assertion, paragraph [0048] of the Naples et al. reference was addressed on page 10, lines 10-21 of the Appeal Brief dated December 6, 2007.

Accordingly, contrary to the Examiner's assertion, Applicants did address paragraphs [0010] and [0048] and Fig. 15A of the Naples et al. reference. The above noted assertion by the Examiner would thus appear to be clearly erroneous, and in effect obscures the prosecution history of this application.

On page 13, lines 15-19 of the Final Office Action dated November 2, 2009, the Examiner has further directed attention to paragraph [0181] and Fig. 12A of the Naples et al. reference as disclosing synchronization data embedded within song data. However, paragraph [0181] of the Naples et al. reference describes cue display 82 that prompts user 16 (the person shown in Fig. 1A) for input stimuli during a live performance. In other words, cue display 82 is merely a television screen that displays spikes 122 indicative of the point in time at which a user 16 is to provide an input stimulus to the virtual instrument input device 28.

In absence of specific clarification by the Examiner, it is presumed that spikes 122 show in cue display 82 in Fig. 12A of the Naples et al. reference have been interpreted by the Examiner as corresponding to the timing cues generally described in paragraph [0049] of the Naples et al. reference. Applicants however respectfully submit that the timing cues as generally described in paragraph [0049] of the Naples et al. reference, and cue display 82 including spikes 122 as shown in Fig. 12A, are not song data having synchronization data embedded therein that is stored in a memory, as would be necessary to meet the features of claim 6. Spikes 122 are merely displayed on a television screen, and are not specifically described in paragraph [0181] as synchronization data or as embedded within song data stored in a memory.

Applicants thus respectfully submit that the Naples et al. reference does not specifically disclose a memory that stores karaoke contents including song data having synchronization data embedded therein, as would be necessary to meet the features of

claim 6. Applicants therefore respectfully submits that the mobile karaoke device of claim 6 distinguishes over the Naples et al. reference as relied upon by the Examiner, and that this rejection of claims 6-12 is improper for at least these reasons.

With further regard to this rejection, Applicants respectfully submit that the Naples et al. reference does not disclose a sound generator that plays sound responsive to song data, and that also sends an interrupt signal to a multimedia processor responsive to receipt of synchronization data embedded within the song data, as would be necessary to meet the further features of claim 6.

On page 4, lines 13-14 of the Final Office Action dated November 2, 2009, the Examiner has generally alleged that Fig. 1A, and the audio output subsystem responsive to output by the system logic, may be interpreted as the sound generator of claim 1. However, audio output subsystem 27 is described in paragraph [0056] of the Naples et al. reference as merely producing sound audible to user 16. Moreover, the system logic 18 as referred to by the Examiner is described in paragraph [0126] of the Naples et al. reference as running applications. In paragraph [0129], system logic 18 is described with respect to Fig. 6 as including classes that define software objects and also as including interfaces that are implemented in the classes. In paragraph [0132], system logic 18 is described as including top-level objects, dynamic objects and interfaces. In paragraph [0134], system logic 18 is described as including system behavior.

Applicants respectfully submit that audio output subsystem 27 and system logic

18 as shown in Fig. 1A of the Naples et al. reference as particularly relied upon by the Examiner are not specifically disclosed or described as a sound generator that generates an interrupt signal responsive to receipt of synchronization data embedded within song data stored in a memory, as would be necessary to meet the further features of claim 6.

On page 5 of the Final Office Action dated November 2, 2009, the Examiner has further directed attention to paragraphs 10, 48, 49, 57 and 164 of the Naples et al. reference as disclosing a sound generator that generates an interrupt signal responsive to receipt of synchronization data embedded within song data stored in a memory.

However, paragraph [0010] of the Naples et al. reference as specifically relied upon merely describes very generally cue data that specifies prompts coordinated with audio content.

Paragraph [0048] of the Naples et al. reference as specifically relied upon by the Examiner merely describes in general that one or more parts can be played back synchronously by an interactive karaoke system.

Paragraph [0049] of the Naples et al. reference as specifically relied upon by the Examiner merely describes that a data file contains additional content such as timing cues, and that the additional content is timed as correlated to audio content for synchronous playback.

Paragraph [0057] of the Naples et al. reference as specifically relied upon by the Examiner merely describes in general system logic 18 as including a player application

and an engine library.

Paragraph [0164] of the Naples et al. reference as specifically relied upon by the Examiner merely describes live interactive playback processes that instruct performance objects.

Applicants respectfully submit that the above noted paragraphs of the Naples et al. reference as particularly relied upon by the Examiner do not specifically describe a sound generator that generates an interrupt signal to a multimedia processor responsive to receipt of synchronization data embedded within song data stored in a memory, as would be necessary to meet the further features of claim 6. Although a variety of paragraphs are cited by the Examiner, the Examiner has failed to specifically and clearly identify in the Naples et al. reference an interrupt signal as generated responsive to synchronization data embedded within song data, as would be necessary to meet the features of claim 6. Applicants thus respectfully submit that the mobile karaoke device of claim 6 distinguishes over the Naples et al. reference as relied upon by the Examiner, and that this rejection of claims 6-12 is improper for at least these reasons.

Applicants also respectfully submit that the karaoke service method for a mobile device of claim 20 distinguishes over the Naples et al. reference as relied upon by the Examiner, and that this rejection of claims 20-25 is improper for at least somewhat similar reasons as set forth above with respect to claim 6.

Conclusion

The Examiner is respectfully requested to enter this Amendment, which merely cancels claims 13-19 and thus materially reduces the issues prior to appeal. That is, entry and consideration of this Amendment would not require any further consideration and/or search, and thus would not be an undue burden.

The Examiner is respectfully requested to reconsider and withdraw the corresponding rejections, and to pass the claims of the present application to issue, for at least the above reasons.

In the event that there are any outstanding matters remaining in the present application, please contact Andrew J. Telesz, Jr. (Reg. No. 33,581) at (571) 283-0720 in the Washington, D.C. area, to discuss these matters.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment for any additional fees that may be required, or credit any overpayment, to Deposit Account No. 50-0238.

Respectfully submitted,

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